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10/521,848	01/21/2005	Minne Van Der Veen	NL 020670	6183

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EXAMINER
SCHWARTZ, DARREN B

ART UNIT	PAPER NUMBER
2135	

MAIL DATE	DELIVERY MODE
08/26/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 July 2008*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☐ All   b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant has amended claims 7 and 14 to obviate the rejection 35 U.S.C. §101.

2.   The Examiner upholds the rejection of claims 7 and 14 under 35 U.S.C. §101 as still directed to non-statutory matter (i.e. software, *per se*)/

3.   Applicant argues, with respect to claim 1, that Shuster fails to teach at least one digital watermark **associated with** <u>the respective first and second data sequences</u>. Applicant states on pages 6-7 of REMARKS, filed 11 July 2008, "The Office then equates Shuster's second checksum with applicants' digital watermark. However, the equivalencies made by the Office cannot hold because applicants claim: at least one digital watermark associated with the respective first and second data sequences. In Shuster the first and second checksums are generated from a file corresponding to two different length portions of the file (col. 5, lines 50-64). Thus, the second checksum in Shuster is from a second portion of the file. The second checksum in Shuster is not associated with the first portion of the file from which the first check sum is calculated."

4.   Therefore, the second checksum in Shuster cannot be said to be equivalent to applicants' claimed: at least one digital watermark **associated with** the respective first and second data sequences, because the second checksum in Shuster is **associated with** a second portion of the file, <u>which is different from the first portion</u>. For at least the foregoing reasons, Shuster does not teach each and every feature of applicants' claim 1 and claim 1 is patentable over Shuster."

5.   The Examiner disagrees and has bolded key words found in claim 1 and

applicant's argument of claim 1. The applicant and applicant's representative are

reminded that although the claims are interpreted in light of the specification, limitations

from the specification are not read into the claims. See *In re Van Geuns*, 988

F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The phrase "associated with" is broadly

interpreted. The Examiner has interpreted, but is not necessary limited to, "calculated

using."

6.   It appears applicant has established that Shuster anticipates the limitation "at

least one digital watermark **associated with** the respective first and second data

sequences."

7.   Applicant states "In Shuster the first and second checksums are generated from

a file corresponding to two different length portions of the file (col. 5, lines 50-64)." This

further conquers the association "...with the respective first and second data

sequences."

Claim Rejections - 35 USC § 101

8.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

9.   Claims 7 and 14 are rejected under 35 U.S.C. 101 because the claims for the

invention are directed to non-statutory subject matter, as they do not fall under any of

the statutory classes of inventions. The language in the claims raise an issue because

the claims are directed merely to an abstract idea that is not tied to an article of

manufacture which would result in a practical application producing a concrete, useful,

and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

The claims could reasonably be drawn to functional descriptive material, per se, i.e.,

"program" may be taken to mean software alone, and as such, the claims would be

directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 1-14 are rejected under 35 U.S.C. 102(e) as being anticipated by

Shuster, (U.S. Pat 6826546 B1), hereinafter referred to as Shuster.

        Re claims 1, 4, 8 and 11: Shuster teaches a method for identifying a first digital

data sequence, a system for identifying a first digital data sequence comprising a

processor (col 4, lines 39-42), a method for enabling identification of a first digital data

sequence and a system for enabling identification of a first digital data sequence (col 5,

lines 30-35) comprising:

- calculating a first digital fingerprint [generate first checksum] based on at least part of

the first sequence ["initial checksum based upon a small amount of data reduces the

burden on the network and file server"] (Fig 1: elt 116 & 120; col 5, lines 55-58 and lines

61-64),

- comparing the first fingerprint [first checksum] with at least a second fingerprint

associated with at least a second digital data sequence ["compares the first checksum

with a library of known checksum values that are stored in database"] (Fig 1: elt 120,

124 & 128; col 5, lines 65 – col 6, line 1),

- depending on a result of the comparison [Fig 1, elt 128] (col 6, lines 3-7), comparing at

least one digital watermark [generate second checksum] associated with the respective

first and second data sequences ["the second checksum is then uploaded to the server,

and is compared to the library of known checksum values for a match in the database"]

(Fig 1: elt 136, 140, 144 & 148; col 6, lines 8 - 12) and thereby establishing an identity of

the first data sequence (Fig 1: elt 148 & 152; col 6, lines 12-13 and lines 15-18).

    Re claims 2, 5, 9 and 12: Shuster further teaches calculating the at least one

digital watermark [second checksum], where the calculation is dependent on information

contained in the first fingerprint (col 6, lines 20-22). Shuster teaches that both

checksums can be calculated based on the first one thousand bytes.

    Re claims 3, 6, 10 and 13: Shuster further teaches calculating the at least one

digital watermark [second checksum], where the calculation is dependent on information

[Fig 1, elt 128] resulting from the comparison between the first fingerprint [first

checksum] and the second fingerprint ["a library of known checksum values that are

stored in database"] (col 5, line 64 – col 6, line 8). Shuster teaches the calculation

between the second checksums is performed only when the first checksums are validated.

Re claims 7 and 14: Shuster teaches a computer program product comprising a computer usable medium including software instructions for controlling a computer to perform a method according to claims 1 and 8 (col 2, lines 45-53; claim 1: col 8, lines 46-50).

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the text of the passage taught by the prior art or disclosed by the examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Pat Pub 2003/0037010 A1

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DARREN SCHWARTZ whose telephone number is (571)270-3850. The examiner can normally be reached on 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571)272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. S./
Examiner, Art Unit 2135
        /KimYen Vu/
        Supervisory Patent Examiner, Art Unit 2135